THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN FINK

Appeal No. 1999-2832
Application No. 08/816,559

ON BRIEF

Before STAAB, NASE, and GONZALES, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 9 to 17. Claims 18 to 21 have been objected to as depending from a non-allowed claim. Claims 1 to 8 have been canceled.

We REVERSE and enter a new rejection pursuant to 37 CFR § 1.196(b).

BACKGROUND

The appellant's invention relates to a sliding door arrangement. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims (the applied prior art) are:

Kaptur et al. (Kaptur)	3,392,812	July 16, 1968
Moreuil	5,077,938	Jan. 7, 1992
Monot	2,118,667 (United Kingdom)	Nov. 2, 1983

Claims 9 to 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Monot in view of Moreuil and Kaptur.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 24, mailed June 21, 1999) for the examiner's complete reasoning in

support of the rejection, and to the brief (Paper No. 23, filed January 26, 1999) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The obviousness rejection

We will not sustain the rejection of claims 9 to 17 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d

1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Upon our evaluation of all the evidence before us (i.e., the applied prior art), it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Specifically, claim 9 includes the following limitations:

> a freewheel mounted on the first end of the spindle so as to enable the spindle to rotate when the at least one door leaf is moving in a closing direction thereof, the freewheel having a component which is stationary relative to but capable of rotating together with the spindle, and a releasable device selected from the group comprising a brake and a clutch configured to prevent rotation of the component of the freewheel.

The above-quoted limitations are not suggested by the applied prior art. In that regard, we have reviewed all the teachings of the applied prior art and fail to find any teaching whatsoever of a freewheel, let alone a suggestion that would have led an artisan to have modified the primary

reference (i.e., Monot) to have included a freewheel arranged as set forth in the above-quoted limitations.

In our view, the only possible suggestion for modifying the applied prior art to arrive at the claimed invention stems from hindsight knowledge derived from the appellant's own disclosure.

The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 9 to 17 under 35 U.S.C. § 103 is reversed.

New ground of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 9 to 21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the

metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

Claim 9 (the only independent claim pending in this application) includes the limitation "a releasable device selected from the group **comprising** a brake and a clutch configured to prevent rotation of the component of the freewheel [emphasis ours]."

Ex parte Markush, 1925 C.D. 126 (Comm'r Pat. 1925) sanctions claiming a group as **consisting of** certain specified members. It is well-settled that it is improper to use the term "comprising" instead of "consisting of." See Ex parte Dotter, 12 USPQ 382 (Bd. App. 1931) and Manual of Patent Examining Procedure (MPEP) § 2173.05(h). Thus, it is our view that claim 9, and all claims dependent thereon, is indefinite for utilizing the term "comprising" in the limitation "a releasable device selected from the group comprising a brake

and a clutch configured to prevent rotation of the component of the freewheel."

Additionally, it is our opinion that the following limitation of claim 9 is vague and indefinite: "the drive being

configured to one of rotate the spindle so that the nut linearly moves the at least one door leaf and directly linearly move the at least one door leaf." It is unclear to us exactly what this limitation is reciting, thus the metes and bounds of claim 9 are not known. Specifically, the use of the phrase "one of" and the repetition that the at least one door leaf is moved linearly renders claim 9 indefinite.

CONCLUSION

To summarize, the decision of the examiner to reject claims 9 to 17 under 35 U.S.C. § 103 is reversed and a new rejection of claims 9 to 21 under 35 U.S.C. § 112, second paragraph, has been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

LAWRENCE J. STAAB Administrative Patent Judge	)
JEFFREY V. NASE Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JOHN F. GONZALES Administrative Patent Judge	)

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